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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,777	10/29/2003	Shinichi Kawano	.244556US6	6717

22850 7590 09/22/2006

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EXAMINER

WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/694,777

Applicant(s)

KAWANO ET AL.

Examiner

William H. Wood

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01272004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-11 are pending and have been examined.

#### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed.

#### ***Information Disclosure Statement***

2. The Information Disclosure Statement filed on 27 January 2004 has been considered.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2193

5. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 is directed toward software alone and is therefore not patentable.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-8 of copending Application No. 10/671,471. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Art Unit: 2193

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

1. A software updating system, comprising: a plurality of update data supplying apparatuses for supplying update confirmation information regarding the presence or absence of updates for predetermined software via a network; an electronic device for executing a process in accordance with said update confirmation information supplied from said update data supplying apparatus, wherein said electronic device includes: judging means for judging whether or not, among installed software, there exists software for which the presence of updates needs to be confirmed; detection means for detecting said update data supplying apparatus to which an inquiry is to be made on the presence of updates for said software for which said judging means has judged a confirmation to be necessary; inquiring means for making an inquiry on the presence of updates for said software to said update data supplying apparatus detected by said detection means; and execution means for executing a process based on said update confirmation information supplied from said update data supplying apparatus in response to said inquiry made by said inquiring means, and said update data supplying apparatus includes: confirmation means for confirming the presence or absence of updates for said software regarding which there was an inquiry on the presence of updates by said inquiring means of said electronic device; and supplying means for supplying to said electronic device said update confirmation information in accordance with a confirmation result by said confirmation means.

2. The software updating system according to claim 1, wherein said update confirmation information is one of update data for updating said software and information indicating the presence or absence of updates.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant

application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-11 are rejected under 35 U.S.C. 102(a) as being anticipated by **Gronemeyer** et al. (USPN 6,363,359).

#### **Claim 1**

**Gronemeyer** disclosed a software updating system, comprising:

a plurality of update data supplying apparatuses for supplying update confirmation information regarding the presence or absence of updates for predetermined software via a network (*figure 4, elements 342 and 344; column 7, lines 56-58, "server"*);

an electronic device for executing a process in accordance with said update confirmation information supplied from said update data supplying apparatus (*figure 4, element 302; column 7, lines 52-54, "client computing device"*), wherein

said electronic device includes:

judging means for judging whether or not, among installed software, there exists software for which the presence of updates needs to be confirmed (*figure 3, element 202; column 7, lines 25-26*);

detection means for detecting said update data supplying apparatus to which an inquiry is to be made on the presence of updates for said software for which said judging means has judged a confirmation to be necessary (*figure 3, element 206; column 7, lines 31-32*);

inquiring means for making an inquiry on the presence of updates for said software to said update data supplying apparatus detected by said detection means (*figure 3, element 208; column 7, lines 56-58*); and

execution means for executing a process based on said update confirmation information supplied from said update data supplying apparatus in response to said inquiry made by said inquiring means (*figure 3, element 210*), and

said update data supplying apparatus includes:

confirmation means for confirming the presence or absence of updates for said software regarding which there was an inquiry on the presence of updates by said inquiring means of said electronic device (*column 7, lines 56-58, to send update options those options are first determined, not "available"*); and

supplying means for supplying to said electronic device said update confirmation information in accordance with a confirmation result by said confirmation means (*column 7, lines 56-58*).

Claim 2

**Gronemeyer** disclosed the software updating system according to claim 1, wherein said update confirmation information is one of update data for updating said software and information indicating the presence or absence of updates (*column 7, lines 56-28*).

Claim 3

**Gronemeyer** disclosed the software updating system according to claim 1, wherein said electronic device further comprises storage means for storing an update confirmation cycle for said installed software, and said judging means judges whether or not, among said installed software, there exists software for which the presence of updates needs to be confirmed based on said update confirmation cycle (*column 7, lines 26-27, "log"; column 7, lines 56-58, results sent*).

Claim 4

**Gronemeyer** disclosed the software updating system according to claim 1, wherein said judging means of said electronic device judges all of said installed



Art Unit: 2193

software to be software for which the presence of updates needs to be confirmed when a predetermined event occurs (*column 6, lines 61-63, "POST"*).

Claim 5

**Gronemeyer** disclosed the software updating system according to claim 4, wherein said event is one of the turning on of the power of said electronic device and the arrival of a predetermined time (*column 6, lines 61-63, "POST" and at the sentinel load time*).

Claim 6

**Gronemeyer** disclosed the software updating system according to claim 1, wherein after said update data supplying apparatus is detected by said detection means, said inquiring means of said electronic device waits until a predetermined time and makes an inquiry on the presence of updates for said software (*figure 3, elements 202 and 208; waits until after configuration inspection*).

Claims 7-11

The limitations of claims 7-11 are substantially the same as for claims 1-6 and are rejected in the same manner.

Art Unit: 2193

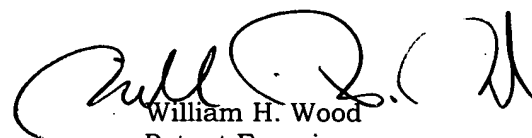
***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



William H. Wood  
Patent Examiner

AU 2193

September 15, 2006